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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/350,297	07/09/1999	YOSHINORI SHIBATA	99143	7865

34055 7590 10/20/2003

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EXAMINER
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RACHUBA, MAURINA T

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 10/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/350,297

Applicant(s)

SHIBATA ET AL.

Examiner

M Rachuba

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34-46 and 55-59 is/are allowed.
- 6) ☒ Claim(s) 17-21, 26-29, 47-49 and 51-54 is/are rejected.
- 7) ☒ Claim(s) 22-25, 30-33 and 50 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. A complete review of the pending application has been made. An election of species requirement was mailed August 1, 2000. Applicant elected species 1, figure 1, in paper no. 6, filed August 25, 2000. A first action on the merits was mailed November 14, 2000 (remailed December 7, 2000). The amendment, canceling claims 1-16 and adding claims 17-59 was filed May 7, 2001. In response a final rejection was mailed July 13, 2001. In this rejection, claims 26, 39, 45, 53 and 55-59 were withdrawn from consideration as being directed to a non-elected species. After considering the request for reconsideration December 21, 2001, claims 55-59 were rejoined, and deemed allowable. Claims 17-59 remain pending. In view of the newly discovered prior art, all previously withdrawn claims have been rejoined. An action on the merits is set forth below. This action is made **non-final** to provide applicant opportunity to respond.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

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directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

(f) he did not himself invent the subject matter sought to be patented.

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

3. Claims 17-21, 26-29, 47-49 and 51-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Des. 415,942 or Des. 420,369. Please refer to figures 1-5 of '942.

It is the examiner's position that '942 discloses the claimed invention, including the battery mounting device and the battery.

4. Claims 17-21, 26-29, 47-49 and 51-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Des 420,369. Please refer to figures 1-5 of '369. It is the examiner's position that '369 discloses the claimed invention, including the battery mounting device and the battery.

5. Claims 17-21, 26-29, 47-49 and 51-54 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. Please refer to figures 1-5 of Des. 415,942, or figures 1-5 of Des 420,369. It is the examiner's position that '942 discloses the claimed invention, including a battery mounting device disposed on the rear of the handle in the positions claimed, and a rechargeable battery. However, '942 has a different inventive entity, in that Hisashi Higuchi is not listed as an inventor of the pending application. As '942 discloses the same invention with an earlier filing

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date, the examiner must conclude that Yoshinori Shibata and Junichi Masuda did not invent the claimed subject matter alone.

6. Claims 17-21, 26-29, 47-49 and 51-54 are directed to the same invention as that of commonly assigned Des.415,942 or Des. 420,369. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved. It appears that the invention as claimed was made in this country by another inventor who had not abandoned, suppressed, or concealed it, based on the disclosure by '942.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

7. Failure to comply with this requirement will result in a holding of abandonment of this application.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 17-21, 26-29, 47-49 and 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Des. 415,942 or Des. 420,369 in view of Judge 6,523,447.

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Please refer to the rejection above. The examiner's position is that '942 or '369 does disclose a rechargeable battery, as evidenced by the push-button on the side of the battery case, which allows the battery to be connected/disconnected from the motor. If applicant argues that it is not apparent that '942 provides a rechargeable battery, then the examiner relies on '447, which teaches providing a miter saw with a rechargeable battery 20. It would have been obvious to have provided '942 or '369 with the battery of '447, to allow use of the tool where electrical power may not be available.

### ***Double Patenting***

10. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

11. Claims 17-21, 26-29, 47-49 and 51-54 are directed to the same invention as that of commonly assigned Des.415,942 or Des. 420,369. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since

the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

***Allowable Subject Matter***

12. Claims 34-46 and 55-59 are allowed.

13. Claims 22-25, 30-33 and 50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

14. Any inquiry concerning the content of this communication or earlier communications from the examiner should be directed to M. Rachuba whose telephone number is (703) 308-1361. The examiner can normally be reached on Monday through Friday from 8:30 AM to 4:00 PM. Any inquiries concerning other than the content of this and previous communications, such as missing references or filed papers not acknowledged, should be directed to the Customer Service Representative, Tech Center 3700, (703) 306-5648.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail, can be reached on (703) 308-2687. The fax phone number for this Group is (703) 872-9302.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

M. RACHUBA  
PRIMARY PATENT EXAMINER  
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A handwritten signature in black ink, appearing to be 'M. Rachuba', written over the printed name.

mtr  
October 16, 2003